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RORY D. RANKIN			SHEPARD, JUSTIN E	
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/044,348

**Applicant(s)**

DUREAU, VINCENT

**Examiner**

Justin E. Shepard

**Art Unit**

2424

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 11 January 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-10 and 12-32 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10 and 12-32 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SI-08)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Arguments***

Applicant's arguments filed 12/30/08 have been fully considered but they are not persuasive.

Page 11, paragraph beginning with "It is unclear":

The applicant argues that there is no remote interface disclosed by Kaars to be replaced with a 2-way remote system as taught by Croy. The examiner respectfully disagrees with the applicant. Kaars discloses a system with a plurality of output devices (figure 1, parts 120, 132, 134, 142, and 150). These devices can require many different compression schemes (paragraph 20) and the system contains a user interface to allow the user to input the identification of the device for the video to be outputted to (paragraph 22). As understood by the examiner, the UI is sent down to the device from the transcoder through output 104. The disclosure also states that there is a cursor is displayed on the television (or other output device) so there must inherently be an input device for the user to control the cursor on the user interface. In the previous office action, the examiner admitted that this was executed by a separate remote control device to communicate with the transcoder 100. Croy teaches a plurality of remote control devices that include both 1-way and 2-way. Therefore it is the opinion of the examiner that it would have been obvious for one of ordinary skill in the art to swap out the 1-way remote controller as disclosed by Kaars with the 2-way remote controller taught by Croy (column 4, lines 10-37).

The applicant continues to argue that even if Croy could be combined with Kaars that it would not meet the claim limitation as the Croy is silent as to transcoding data from device 100 to device 200 as seen in figures 1 and 2. The examiner feels that this is a literal interpretation of the references and that using a broader read that one would be able to see that you could swap the remote controllers as stated above without changing the functionality of the transcoding of Kaars. Therefore the combination is seen as valid and meeting the claim limitation.

Page 12, paragraph beginning with "In addition":

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the motivation would have been to enable all of the diverse devices disclosed by Kaars to be able to control the transcoding unit regardless of the network they are connected to.

Page 13, paragraph beginning with "As my be seen":

Once again, the applicant seems to be arguing that device 200 taught by Croy could not be combined with the transcoding system disclosed by Kaars as it would

create a standard device that teaches away from the diverse devices disclosed by Kaars. The device itself is not being combined, just the communication method taught by Croy and therefore the combination is valid.

Page 13, last paragraph:

The applicant argues that Kaars does not meet the limitations of claim 30. Two paragraphs later the applicant admits that Kaars teaches automatic transcoding of data, and there is no disclosure that the user in Kaars controls the device to download a new codec and therefore is considered to be automatically downloaded when needed.

Page 14, last paragraph:

The applicant argues that as a user inputs what kind of device is being used that this does not meet the limitation of "automatically retrieving the transcode subunit." The examiner is interpreting the limitation of automatic as not needing a user to search out and download a new codec. The examiner suggests adding a limitation to better clarify the term "automatic."

Page 16, last paragraph:

The applicant argues that the combination does not meet the 2 prong limitation found in claim 8 of determining the first data format is not compatible with the second data format and determining no transcode subunit corresponding to both the first data and the target data format is available. The examiner would argue that Kaars always

determines whether the first data format is compatible with the second device. Plourde is used to teach that there might be a situation arise wherein there is no codec can be found as the data rate is too high to be decoded by the device using the available codecs then the data is discarded. The examiner stands by the rejection of claim 8 as being proper.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-5, 13, 20, 28, and 29-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kaars in view of Croy.

Referring to claim 1, Kaars discloses a client for use in a television system, wherein the client is located in a television viewer home (figure 1) and comprises:

a receiver configured to receive a programming signal (figure 1);

an interface configured to communicate with a secondary device external to the client (figure 1, parts 104 and 150; paragraphs 22 and 28); and

a transcode subsystem coupled to the receiver and the interface (paragraph 21), wherein the transcode subsystem is configured to:

determine a target data format corresponding to the secondary device (paragraph 28);

convey a request to an external entity for a transcode subunit corresponding to said target data format, in response to determining the transcode subsystem is not configured to support said target data format (paragraphs 28 and 35);

retrieve the transcode subunit from an external entity, responsive to the request (paragraph 35);

receive data targeted to the secondary device, wherein the received data comprises a first data format (figure 2A; part 200);

determine whether the first data format is compatible with the secondary device (paragraph 28);

identify the transcode subunit as corresponding to both the first data format and the target data format, in response to determining the first data format is not compatible with the secondary device (paragraph 28); and

initiate transcoding of the received data from the first data format to the target data format using the transcode subunit (figure 2B; parts 214 and 216).

Kaars does not disclose a system to detect a communication from the secondary device.

In an analogous art, Croy teaches a system to detect a communication from the secondary device (column 4, lines 10-37).

At the time of the invention, it would have been obvious for one of ordinary skill in the art to add the two-way remote control device taught by Croy to replace the one-way remote control system disclosed by Kaars. The motivation would have been to enable all of the diverse devices disclosed by Kaars (figure 1, parts 120, 132, 134, 142, and

150) to be able to control the transcoding unit regardless of the network they are connected to.

Claims 13 and 20 are rejected on the same grounds as claim 1.

Referring to claim 2, Kaars discloses a client of claim 1, wherein the transcode subsystem includes a config table configured to associate the secondary device with the target data format (figure 2A, parts 208).

Referring to claim 3, Kaars discloses a client of claim 1, wherein the transcode subsystem comprises a control unit configured to access the config table to determine the target data format, and wherein the transcode subsystem is further configured to register the secondary device in response to determining the transcode subsystem is configured to support said target data format (paragraph 28).

Referring to claim 4, Kaars discloses a client of claim 1, wherein the transcode subsystem comprises a transcode subunit configured to perform the transcoding (paragraph 28; Note: as the transcoding is performed by software stored in memory, the examiner is interpreting each piece of transcoding software as a transcode subunit).

Referring to claim 5, Kaars discloses a client of claim 4, wherein the transcode subsystem further comprises a second transcode subunit configured to transcode data to a second data format (paragraph 28).



Referring to claim 28, Kaars discloses a client as recited in claim 1, wherein the transcode subsystem is configured to store a plurality of transcode subunits, each of which transcodes data from one format to a different format (paragraph 28).

Referring to claim 29, Kaars discloses a client as recited in claim 1, wherein said secondary device is selected from the group consisting of: a television, personal digital assistant, video monitor, video camera, electronic tablet, audio speakers, audio receiver, cell phone, game console, web based server, and a remote control (paragraph 25).

Referring to claim 30, Kaars discloses a client as recited in claim 1, wherein the transcode subsystem is further configured to automatically retrieve the transcode subunit from an external entity without receiving a user request for the transcode unit (paragraphs 23 and 28).

Claims 31 and 32 are rejected on the same grounds as claim 30.

Claims 6, 7, 14, 15, 16, 21, 22, 23, and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kaars and Croy as applied to the claims above, and further in view of Krapf.

Referring to claim 6, Kaars and Croy do not disclose a client of claim 2, wherein the transcode subsystem is configured to: detect an additional secondary device; and register the additional secondary device.

In an analogous art, Krapf teaches a client of claim 2, wherein the transcode subsystem is configured to: detect an additional secondary device; and register the additional secondary device.

At the time of the invention it would have been obvious for one of ordinary skill in the art to register the device as taught by Krapf in the system disclosed by Kaars and Croy. The motivation would have been to enable the STB to determine what content is stored on the device (Krapf: column 6, lines 61-67).

Claims 15 and 22 are rejected on the same grounds as claim 6.

Referring to claim 7, Kaars discloses a client of claim 6, wherein registering the additional secondary device comprises storing an entry corresponding to the secondary device in the config table, wherein the entry indicates the corresponding target data format (paragraphs 28 and 35).

Claims 16 and 23 are rejected on the same grounds as claim 7.

Claims 14, 21, and 25 are rejected on the same grounds as claims 6 and 7.

Claims 8, 17, 22, and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kaars and Croy as applied to the claims above, and further in view of Plourde.

Referring to claim 8, Kaars and Croy do not disclose a client as recited in claim 1, wherein the transcode subsystem is configured to:

discard the second received data in response to determining the first data format is not compatible with the secondary device, and determining no transcode subunit corresponding to both the first data format and the target data format is available.

In an analogous art, Plourde teaches a client as recited in claim 1, wherein the transcode subsystem is configured to:

discard the second received data in response to determining the first data format is not compatible with the secondary device, and determining no transcode subunit corresponding to both the first data format and the target data format is available (page 14, paragraph 107, lines 22-24).

At the time of the invention it would have been obvious for one of ordinary skill in the art to add the method of determining that no transcode subunit is available, as taught by Plourde, to the system disclosed by Kaars and Croy. The motivation would have been to stop large bit-rate files from being downloaded and using up the storage space (Plourde: page 14, paragraph 107, lines 24-27).

Claims 17, 24, and 26 are rejected on the same grounds as claim 8.

Claims 9, 10, 18, 19, and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kaars and Croy as applied to the claims above, and further in view of Chatani.

Referring to claim 9, Kaars and Croy do not disclose a client of claim 1, wherein the transcode subunit is further configured to display an indication to a viewer as to where the transcode subunit may be obtained, in response to determining said transcode subunit is not automatically retrievable.

In an analogous art, Chatani teaches a client of claim 1, wherein the transcode subunit is further configured to display an indication to a viewer as to where the transcode subunit may be obtained, in response to determining said transcode subunit is not automatically retrievable (page 7, column 2, lines 14-17).

At the time of the invention it would have been obvious for one of ordinary skill in the art to add the website software purchasing taught by Chatani to the system disclosed by Kaars and Croy. The motivation would have been to make it simple for users to upgrade their STB with software developed by users (Kaars: paragraph 35).

Claim 18 is rejected on the same grounds as claim 9.

Referring to claim 10, Kaars and Croy do not disclose a client of claim 9, wherein said indication comprises a message selected from the group consisting of: a location where the requested subunit may be purchased; and a link to a website where the requested subunit may be obtained.

In an analogous art, Chatani teaches a client of claim 9, wherein said indication comprises a message selected from the group consisting of: a location where the requested subunit may be purchased; and a link to a website where the requested subunit may be obtained (page 7, column 2, lines 14-17).

At the time of the invention it would have been obvious for one of ordinary skill in the art to add the website software purchasing taught by Chatani to the system disclosed by Kaars and Croy. The motivation would have been to make it simple for users to upgrade their STB with software developed by users (Kaars: paragraph 35).

Claim 19 is rejected on the same grounds as claim 10.

Claim 27 is rejected on the same grounds as claims 9 and 10.

Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kaars and Croy as applied to claim 1 above, and further in view of Moroney.

Referring to claim 12, Kaars and Croy do not disclose a client of claim 1, wherein the client is further configured to: receive a first request from the secondary device for remote data; and generate a second request corresponding to said first request, wherein said second request does not include an indication of a data format required by said secondary device.

In an analogous art, Moroney teaches a client of claim 1, wherein the client is further configured to: receive a first request from the secondary device for remote data; and generate a second request corresponding to said first request, wherein said second request does not include an indication of a data format required by said secondary device (column 8, lines 19-22).

At the time of the invention it would have been obvious for one of ordinary skill in the art to add the user inputted transcoding settings taught by Moroney to the system disclosed by Kaars and Croy. The motivation would have been to allow the user to

store a lower resolution copy when available storage space was running low, therefore preserving the remaining space.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Justin E. Shepard whose telephone number is (571) 272-5967. The examiner can normally be reached on 7:30-5 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Kelley can be reached on (571) 272-7331. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Chris Kelley/  
Supervisory Patent Examiner, Art  
Unit 2424

JS